REMARKS

Claims 54-107 are pending in this application.

Restriction/Election of Species

Applicants have elected with traverse Group I, drawn to methods for inhibiting cell adhesion, optionally wherein the cell adhesion is VCAM-1 mediated, claims 54, 55, 57-95 and 97.

In response to the Election of Species Requirement, Applicants elected 5-phenyl methimazole (1-methyl-5-phenyl-imidazoline-2(3) thione). Applicants wish to note that the Examiner's office action describes this as an election of 5-**methyl** methimazole (although also noted to be the formula 1-methyl-5-phenyl-imidazoline-2(3) thione). Applicants will use the nomenclature 5-phenyl methimazole for consistency with the specification and previous responses.

Claims 56 and 69-107, are presently withdrawn from consideration by the Examiner, as drawn to non-elected subject matter, 37 CFR 1.142(b). Claims 54, 55 and 57-68, drawn to methods for inhibiting cell adhesion, optionally wherein the cell adhesion is VCAM-1 mediated, comprising administering 5-phenyl methimazole, represent the subject matter initially under consideration.

Applicants understand that, upon the allowance of a generic claim, Applicants will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

Rejections

The Examiner has rejected claim 57 under 35 U.S.C. 112, second paragraph, as being indefinite for containing parenthetical subject matter. Applicants have now amended the claims to remove any parenthetical subject matter.

The Examiner has also rejected claim 57 for reciting the limitation "the disease or condition" without sufficient antecedent basis for this limitation in the claim. Applicants have now amended claim 54 to provide for proper antecedent basis for this limitation.

Claims 54, 55 and 57-68 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 59-67 of co-pending Application No. 10/912,948.

Claims 54, 55 and 57-68 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 139-304 of co-pending Application No. 11/130,922.

Claims 54, 55 and 57-68 are provisionally rejected on the ground of nonstatutory double patenting as being unpatentable over claims 61-64 of co-pending Application No. 10/830,898.

Claims 54, 55 and 57-68 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 23-33 and 42-44 of U.S. Patent No. 6,365,616.

Applicants assert that they will file a Terminal Disclaimer (and filing fee) assuring that the present application and co-pending co-pending Application Nos. 10/912,948, 11/130,922 and 10/830,898 and U.S. Patent No. 6,365,616 will expire at the same time if conflicting claims are issued. The filing of this Terminal Disclaimer should render moot the above-referenced double patenting rejections.

The Examiner has rejected claims 54, 55 and 57-68 under 35 U.S.C. 102(b) as being anticipated by Kohn et al., U.S. Patent 6,365,616.

The Examiner claims that the '616 patent teaches the administration of 5-methyl methimazole to treat autoimmune diseases such as autoimmune glomerulonephritis (instant claim 57) or systemic lupus erythromatosus (instant claim 68).

Applicants have now amended the claims to provide for the treatment of cardiovascular diseases.

The Examiner has rejected claims 54, 55 and 57-68 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement because claims 54, 55, 58 and 61 recite "derivatives," with respect to various tautomeric and non-tautomeric methimazole compounds. The Examiner contends that there is insufficient written description for this claim limitation in the disclosure since the term "derivative" encompasses a plethora of possible compounds. The claims have now been amended to provide for a limited set of compounds.

Applicants have now amended the claims to provide for a limited set of derivatives as described in the specification.

The Examiner has rejected claims 58-68 under 35 U.S.C. 112, first paragraph, as containing subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention.

The Examiner objects to the claims being directed to preventing cell adhesion, cytokine-induced cell adhesion, cytokine-induced cell adhesion-associated inflammation, cell adhesion associated with immune or autoimmune responses and diverse diseases. The Examiner contends that the specification does not reasonably provide enablement for the methods of prevention within the full scope of the claimed compounds.

Applicants have now amended the claims to remove use as a method of prevention.

The Examiner has also rejected claim 57 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The Examiner contends that the invention is drawn to preventing cell adhesion, cytokine-induced cell adhesion, cytokine-induced cell adhesion-associated inflammation, cell adhesion associated with immune or autoimmune responses and diverse autoimmune and/or inflammatory diseases and is therefore drawn to a diverse group of diseases or conditions of unrelated etiology.

Applicants have now amended the claims to remove use as a method of prevention and have now amended the claims to provide for the treatment of cardiovascular diseases.

CONCLUSION

In light of the amendments and remarks made herein, it is respectfully submitted that the claims currently pending in the present application are in form for allowance. Accordingly, reconsideration of those claims, as amended herein, is earnestly solicited. Applicants encourage the Examiner to contact their representative, Stephen R. Albainy-Jenei at (513) 651-6839 or salbainyjenei@fbtlaw.com.

The Commissioner for Patents is hereby authorized to charge any deficiency or credit any overpayment of fees to Frost Brown Todd LLC Deposit Account No. 06-2226.

Respectfully submitted,

LEONARD D. KOHN, et al.

By _____

Stephen R. Albainy-Jenei
Registration No. 41,487
Attorney for Applicant(s)
FROST BROWN TODD LLC
2200 PNC Center
201 East Fifth Street
Cincinnati, Ohio 45202
(513) 651-6823
salbainyjenei@fbtlaw.com